

Remarks/Arguments**I. Status**

The Office Action dated June 15, 2007 (the “Office Action”), has been carefully reviewed. Claims 1-3, 20-21, 25, 28 and 30 have been amended and claims 12-19 have been cancelled. Accordingly, claims 1-11 and 20-30 are pending in this application. Reconsideration of this application is respectfully requested.

II. 35 U.S.C. § 102 Rejection

Claims 1, 2, 4, 8, 11, 25-27 and 29 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,896,886 to Wendt (hereinafter “Wendt”). Reconsideration of these claims in view of the following remarks is respectfully requested.

*Discussion Re: Patentability of Claim 1***1. Claim 1**

Claim 1 recites:

A handheld instrument for insertion of an acetabular liner into an acetabular cup comprising:
a shaft having an internal channel therethrough and a first and a second end portion, the first end portion configured to sealingly engage with a bulb syringe;
a bulb syringe sealingly engaged with the first end portion of the shaft and operably connected to the internal channel of the shaft; and
a head portion having a curvilinear outer perimeter configured to sealingly engage the inner surface of an acetabular liner and operably attached to the second end portion of the shaft and having an inner channel therethrough operably connected to the internal channel of the shaft.

Claim 1, as amended, thus recites a device with a head that is configured to sealingly engage the inner surface of an acetabular liner.

2. Wendt Does Not Disclose An Internal Seal

The Examiner alleged that Wendt disclosed a device that included all of the structural limitations of claim 1. (Office Action at pages 2-3). Claim 1 has been amended to clarify that the structure of the claimed invention that engages an acetabular liner is located on the *outer* perimeter of the head.

Specifically, claim 1, as amended, recites a head portion that sealingly engages the *internal* surface of an acetabular liner. Accordingly, the acetabular liner is maintained in position on the inserter by forces applied to the internal surface of the liner by the *outer* perimeter of the head. In contrast, the oil filter wrench of Wendt grips an oil can by forcing the serrated jaws 13 against the “oil filter outer surface.” (Wendt at column 2, lines 58-59 and FIG. 2). Thus, while the gripping of Wendt is accomplished by the structure of the *inner* surface of the jaws 13, the device of claim 1 accomplishes a seal because of the *outer* surface of the head. A structure for gripping the *outside* surface of an object is not the same as a structure for engaging an internal surface of an object.

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Wendt does not disclose each and every element of Applicant’s claim 1, Wendt does not anticipate claim 1. Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 1.

Discussion Re: Patentability of Claims 2, 4, 8 and 11

Each of claims 2, 4, 8 and 11 depend from claim 1 and include all of the limitations of claim 1. Therefore, for at least the reasons set forth above with respect to claim 1, claims 2, 4, 8 and 11 are patentable over the prior art.

*Discussion Re: Patentability of Claim 25*1. Claim 25

Claim 25 recites:

An instrument for insertion of an acetabular liner into an acetabular cup comprising:

a shaft having an internal channel therethrough and a first and a second end portion, the first end portion configured to sealingly engage with a hand held vacuum producing device; and

a head portion having a curvilinear outer perimeter configured to abut a 360 degree portion of the inner surface of an acetabular liner and operably attached to the second end portion of the shaft and having an inner channel therethrough operably connected to the internal channel of the shaft.

Claim 25, as amended, thus recites a device with a head configured to abut a 360 degree portion of the inner surface of an acetabular liner.

2. Wendt Does Not Disclose 360 Degree Abutment

The Examiner alleged that Wendt disclosed a device that included all of the structural limitations of claim 25. (Office Action at pages 2-3). Claim 25 has been amended to clarify that the head is configured to abut the internal surface of an acetabular liner.

Specifically, claim 25, as amended, recites a head configured to abut the inner surface of an acetabular liner about a “360 degree portion.” Accordingly, the head is

configured to be adjacent to the inner surface of an acetabular liner completely about the opening of the acetabular liner. In contrast, the oil filter wrench of Wendt grips an oil can by forcing the serrated jaws 13 against the “oil filter outer surface.” (Wendt at column 2, lines 58-59 and FIG. 2). Thus, while the gripping of Wendt is accomplished by the structure of the *inner* surface of the jaws 13, the device of claim 25 accomplishes a seal because of the *outer* surface of the head. A structure for gripping the *outside* surface of an object is not the same as a structure for engaging an internal surface of an object.

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Wendt does not disclose each and every element of Applicant’s claim 25, Wendt does not anticipate claim 25. Therefore, the Examiner is respectfully requested to withdraw the rejection of claim 25.

Discussion Re: Patentability of Claims 26, 27, 29 and 30

Each of claims 26, 27, 29 and 30 depend, either directly or by way of another claim, from claim 25 and include all of the limitations of claim 25. Therefore, for at least the reasons set forth above with respect to claim 25, claims 26, 27, 29 and 30 are patentable over the prior art.

III. 35 U.S.C. § 103 Rejections

A. Claims 3 and 28

Claims 3 and 28 were rejected under 35 U.S.C. § 103 as being unpatentable over Wendt in view of U.S. Patent No. 3,723,995 of Baumann (hereinafter “Baumann”).

Reconsideration of these claims in view of the following remarks is respectfully requested.

Discussion Re: Patentability of Claim 3

1. Claim 3

Claim 3 recites:

The instrument of claim 2, the head portion further comprising:
a second o-ring circumscribing the curvilinear outer perimeter of the head portion
and adjacent the first o-ring, and
a secondary inner channel having a first and a second end portion and operably
connected at the first end portion to the internal channel and opening at the second end
portion at the outer perimeter of the head portion between the first and second o-ring.

Claim 3 thus recites a head portion with two o-rings and a channel that opens between the o-rings.

2. The Discussion of Claim 1 Applies

The Examiner relied primarily upon Wendt for the limitations of claim 3, with further reference to Baumann for the second o-ring. (Office Action at page 4). Claim 3, however, depends from claim 1 through claim 2. Accordingly, even if Wendt is modified in the manner proposed by the Examiner, such modification fails to correct the deficiencies of Wendt with respect to the limitations of claim 1. Therefore, for at least the same reasons set forth above with respect to claim 1, claim 3 is patentable over the combination of Wendt and Baumann.

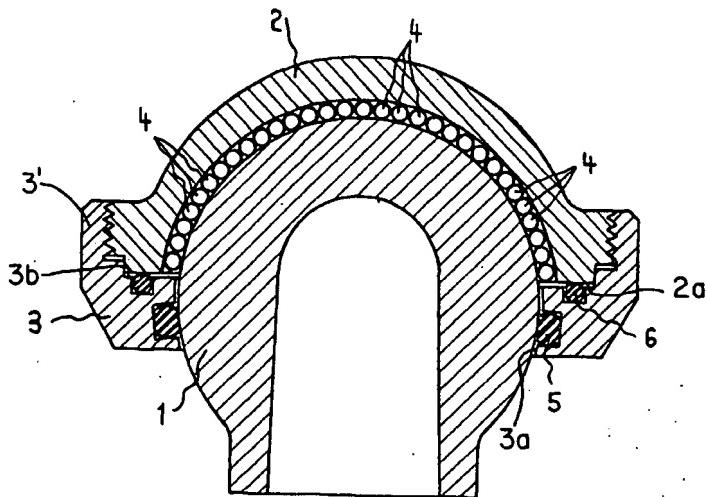
3. Prima Facie Obviousness Has Not Been Alleged

Moreover, claim 3 recites “a secondary inner channel.” The “secondary channel” connects the internal channel to the space between the o-rings. The Examiner has failed to identify any such secondary inner channel in the prior art. Under MPEP § 2142, the prior art must teach or suggest all of the claim limitations. Therefore, even assuming that Baumann discloses a second o-ring, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of claim 3.

4. Baumann Does Not Disclose a Head with Two O-rings

Finally, the Examiner has cited to Baumann for disclosing a second o-ring. (Office Action at page 4). Respectfully, Baumann has been mischaracterized.

Specifically, the Examiner has averred that “Baumann discloses two o-rings/grooves/channels, e.g. 5 and 6, in an acetabular head, e.g. 1 and liner, e.g. 2.” The device of Baumann is shown in the figure below:



Baumann describes the device as including “a joint ball 1,” “a ring 3,” and a “joint pan 2.” (Baumann at column 1, lines 38-46). The o-rings 5 and 6 are located on the ring 3,

not the joint ball 1. In fact, only one of the o-rings (o-ring 5) contacts the head 1. Therefore, even if the joint ball of Baumann is considered to be a “head,” the “head” of Baumann does not include *two* o-rings.

Therefore, because the Examiner has not identified a head with two o-rings, the proposed combination does not arrive at the invention recited in claim 3. Accordingly, under MPEP § 2143.03, claim 3 is patentable over the prior art.

5. There is No Motivation for the Proposed Combination

Moreover, the Examiner has proposed that the motivation for combining Wendt and Baumann is to provide “proper sealing engagement.” (Office Action at page 4). Presumably, the argument is that if one seal is good for eliminating a leak path, then two seals must be better at eliminating the leak path. The “second” o-ring of Baumann, however, does not provide better sealing of a leak path. Rather, the o-ring 6 in the device of Baumann is used to seal a first leak path between the ring 3 and the joint pan 2 while the o-ring 5 is used to seal a second leak path between the ring 3 and the joint ball 1.

Thus, Baumann merely discloses using a single o-ring for any given leak path. Accordingly, the Examiner has not explained why one of ordinary skill in the art would provide a second o-ring on the device of Wendt. Therefore, it is respectfully submitted that there is no motivation for the proposed combination.

6. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the rejection of claim 3 as being obvious over Wendt in view of Baumann has been

successfully traversed, and the Applicants respectfully submit that the rejection of claim 3 under 35 U.S.C. § 103 should be withdrawn.

Discussion Re: Patentability of Claim 28

1. Claim 28

Claim 28 recites:

The instrument of claim 27, the head further comprising:
a second groove circumscribing the curvilinear outer perimeter of the head and adjacent the first groove;
a second o-ring located within the first groove; and
a secondary inner channel having a first and a second end portion and operably connected at the first end portion to the internal channel and opening at the second end portion at the outer perimeter of the head between the first and second groove.

Claim 28 thus recites a head portion with two o-ring grooves and a channel that opens between the o-ring grooves.

2. The Discussion of Claim 25 Applies

The Examiner relied primarily upon Wendt for the limitations of claim 28, with further reference to Baumann for the second o-ring groove. (Office Action at page 4).
Claim 28, however, depends from claim 25 through claim 27. Accordingly, even if Wendt is modified in the manner proposed by the Examiner, such modification fails to correct the deficiencies of Wendt with respect to the limitations of claim 25. Therefore, for at least the same reasons set forth above with respect to claim 25, claim 28 is patentable over the combination of Wendt and Baumann.

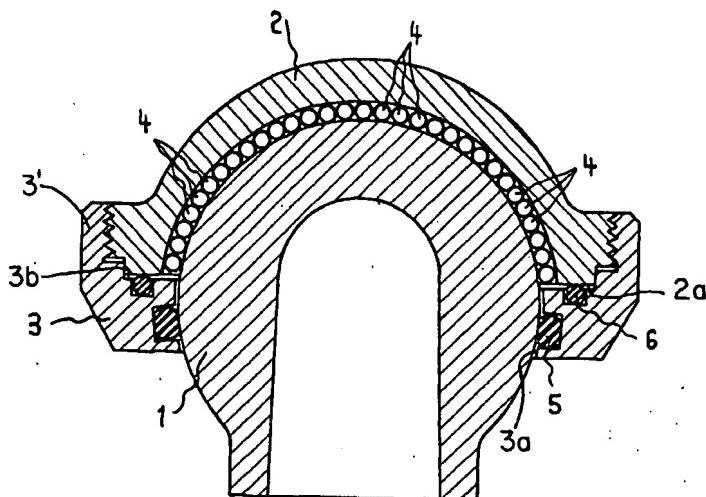
3. Prima Facie Obviousness Has Not Been Alleged

Moreover, claim 28 recites “a secondary inner channel.” The “secondary channel” connects the internal channel to the space between the o-ring grooves. The Examiner has failed to identify any such secondary inner channel in the prior art. Under MPEP § 2142, the prior art must teach or suggest all of the claim limitations. Therefore, even assuming that Baumann discloses a second o-ring, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established with regard to the invention of claim 28.

4. Baumann Does Not Disclose a Head with Two O-ring Grooves

Finally, the Examiner has cited to Baumann for disclosing a second o-ring groove. (Office Action at page 4). Respectfully, Baumann has been mischaracterized.

Specifically, the Examiner has averred that “Baumann discloses two o-rings/grooves/channels, e.g. 5 and 6, in an acetabular head, e.g. 1 and liner, e.g. 2.” The device of Baumann is shown in the figure below:



Baumann describes the device as including “a joint ball 1,” “a ring 3,” and a “joint pan 2.” (Baumann at column 1, lines 38-46). The o-rings 5 and 6 are located in grooves on the ring 3, not the joint ball 1. In fact, only one of the o-rings (o-ring 5) contacts the head 1. Therefore, even if the joint ball of Baumann is considered to be a “head,” the “head” of Baumann does not include *two* o-ring grooves.

Therefore, because the Examiner has not identified a head with two o-ring grooves, the proposed combination does not arrive at the invention recited in claim 28. Accordingly, under MPEP § 2143.03, claim 28 is patentable over the prior art.

5. There is No Motivation for the Proposed Combination

Moreover, the Examiner has proposed that the motivation for combining Wendt and Baumann is to provide “proper sealing engagement.” (Office Action at page 4). For the same reason set forth above with respect to the motivation for combining Wendt and Baumann with respect to claim 3, there is no motivation for the proposed combination of Wendt and Baumann with respect to claim 28. Therefore, it is respectfully submitted that there is no motivation for the proposed combination.

6. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the rejection of claim 28 as being obvious over Wendt in view of Baumann has been successfully traversed, and the Applicants respectfully submit that the rejection of claim 28 under 35 U.S.C. § 103 should be withdrawn.

Discussion Re: Patentability of Claim 29

Claim 29 depends from claim 25 and includes the limitations discussed above with respect to claim 25 and additional limitations. Accordingly, for at least the same reasons set forth above with respect to claim 25, claim 29 is patentable over the prior art.

B. Claims 5-7

Claims 5-7 were rejected under 35 U.S.C. § 103 as being unpatentable over Wendt in view of U.S. Patent No. 6,620,132 of Skow (hereinafter “Skow”).
Reconsideration of these claims in view of the following remarks is respectfully requested.

*Discussion Re: Patentability of Claim 5***1. Claim 5**

Claim 5 recites:

The instrument of claim 1, further comprising:

a stop check valve having an inlet and an outlet, the inlet operably connected to the internal channel and the outlet operably connected to the atmosphere, such that when the stop check valve is in a non-stopped position, air from the atmosphere is not allowed to pass into the internal channel through the stop check valve but air from the internal channel is allowed to pass to the atmosphere through the stop check valve and such that when the stop check valve is in a stopped position, air from the internal channel is not allowed to pass into the atmosphere through the stop check valve; and

a valve movable between a first position and a second position and having an inlet and an outlet, the inlet operably connected to the atmosphere and the outlet operably connected to the bulb syringe, such that when the valve is in the first position, air is not allowed to pass between atmosphere and the internal channel, and when the valve is in the second position, air is allowed to pass between the atmosphere and the internal channel.

Claim 5 thus recites two valves, each valve connected the atmosphere, one valve also connected to the bulb syringe and the other valve connected to the internal channel.

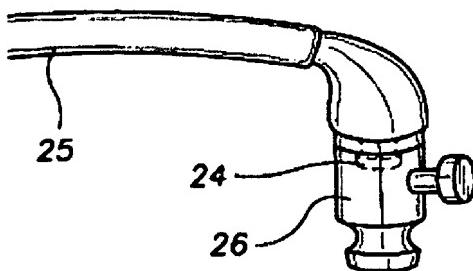
2. The Discussion of Claim 1 Applies

The Examiner relied primarily upon Wendt for the limitations of claim 5, with further reference to Skow for the second valve. (Office Action at page 4). Claim 5, however, depends from claim 1. Accordingly, even if Wendt is modified in the manner proposed by the Examiner, such modification fails to correct the deficiencies of Wendt with respect to the limitations of claim 1. Therefore, for at least the same reasons set forth above with respect to claim 1, claim 5 is patentable over the combination of Wendt and Skow.

3. Skow Does Not Disclose Two Valves Connected to Atmosphere

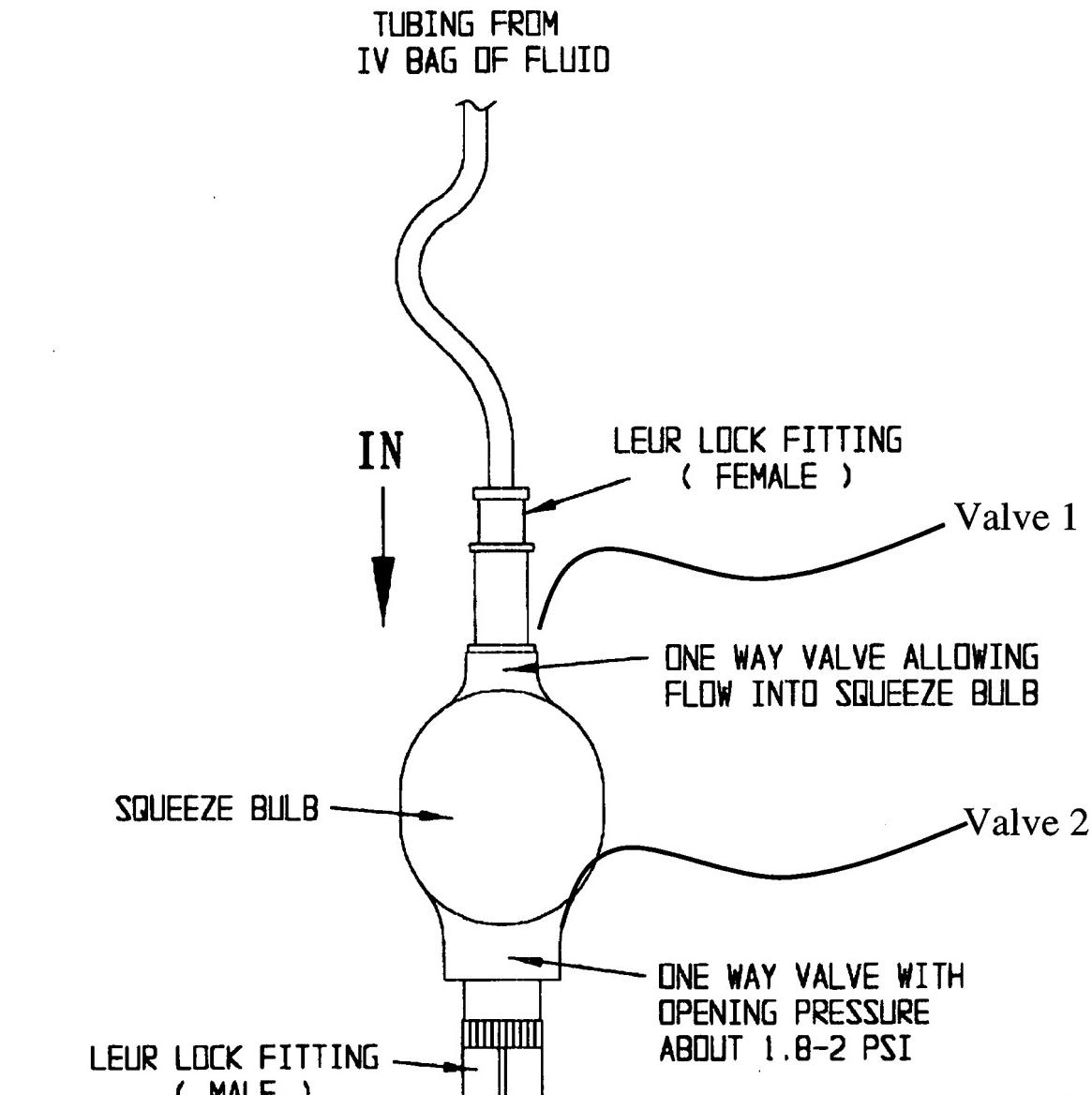
The Examiner has cited to Skow for disclosing a second valve. (Office Action at page 4). Respectfully, Skow does not disclose a valve configured in the manner recited in claim 5.

Specifically, the Examiner relied upon Wendt for one valve. The valve of Wendt is shown in FIG. 2, a portion of which is set forth below.



Wendt further discloses that a tube 31 may be attached to the nipple 24 and a suction bulb 35 attached to the other end of the tube 31. (Wendt at column 3, lines 9-21). Thus, Wendt arguably discloses a valve located between "an internal channel" and "a bulb syringe."

The Examiner has cited to FIG. 19 of Skow for disclosing a second valve. FIG. 19 of Skow, a portion of which is set forth below, identifies two valves which are identified for purposes of this discussion as "Valve 1" and Valve 2."



Thus, Valve 1 is arguably located between atmosphere (the IV bag) and the squeeze bulb while Valve 2 is located between the squeeze bulb and the leur lock to which a tube with an "internal channel" is attached (see, e.g. FIG. 18 and discussion at column 6, line 60 through column 7, line 5).

Thus, by combining the teaching of Wendt and Skow, the Examiner has arguably identified two valves between “an internal channel” and “a bulb syringe” and one valve between a bulb syringe and atmosphere. Claim 5 recites, however, one valve with “the inlet operably connected to the internal channel and the outlet operably connected to the atmosphere.” None of the valves identified by the Examiner are configured in this manner.

Therefore, because the Examiner has not identified a valve between an internal channel and atmosphere, the proposed combination does not arrive at the invention recited in claim 5. Accordingly, under MPEP § 2143.03, claim 5 is patentable over the prior art.

4. There is No Motivation for the Proposed Combination

Moreover, the Examiner has proposed that the motivation for combining Wendt and Skow is to “prevent liquid from exiting the valve until a predetermined amount of pressure is provided by the bulb actuation.” (Office Action at page 5). This argument has no readily apparent connection to the placement of a valve between an internal channel and atmosphere.

Thus, the Examiner has not explained why one of ordinary skill in the art would place a valve between the inner channel of the Wendt device and atmosphere. Therefore, it is respectfully submitted that there is no motivation for the proposed combination.

5. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the rejection of claim 5 as being obvious over Wendt in view of Skow has been successfully traversed, and the Applicants respectfully submit that the rejection of claim 5 under 35 U.S.C. § 103 should be withdrawn.

Discussion Re: Patentability of Claims 6-7

Claims 6-7 depend from claim 5 and include the same limitations as claim 5 and additional limitations. Accordingly, for at least the same reasons as set forth above with respect to claim 5, claims 6-7 are patentable over the prior art.

C. Claims 9-10

Discussion Re: Patentability of Claims 9-10

The Examiner relied primarily upon Wendt for the limitations of claims 9 and 10 with further reference to “routine skill” for the limitations added by claims 9 and 10. (Office Action at page 5). Claims 9-10, however, depend from claim 1 through claim 8. Accordingly, even if Wendt is modified in the manner proposed by the Examiner, such modification fails to correct the deficiencies of Wendt with respect to the limitations of claim 1. Therefore, for at least the same reasons set forth above with respect to claim 1, claims 9-10 are patentable over Wendt.

D. Claims 20-22

Claims 20-22 were rejected under 35 U.S.C. § 103 as being unpatentable over Wendt in view of U.S. Patent Publication No. 2005/0015059 of Sweeney (hereinafter

“Sweeney”). Reconsideration of these claims in view of the following remarks is respectfully requested.

Discussion Re: Patentability of Claim 20

1. Claim 20

Claim 20 recites:

A kit providing a handheld instrument for insertion of an acetabular liner into an acetabular cup comprising:

a shaft having an internal channel therethrough and a first and a second end portion, the first end portion configured to sealingly engage with a bulb syringe, the second end configured to sealingly engage with a head; and

a plurality of heads, each head having a curvilinear outer perimeter and configured to be operably attached to the second end portion of the shaft such that an inner channel of the head connects to the internal channel of the shaft, each of the plurality of heads having a curvilinear outer perimeter sized to at least partially fit within an acetabular liner.

Claim 20 thus recites a kit for an instrument to insert an acetabular liner within an acetabular cup, the instrument having a shaft and interchangeable heads.

2. No Motivation to Combine References

The Examiner has utilized Wendt as a main reference for teaching a suction inserter with further reference to Sweeney for the proposition of providing a kit with a plurality of heads. (Office Action at page 5). One of ordinary skill in the art would not be motivated to combine the teachings of Wendt with Sweeney, since there is no benefit provided by the combination.

Specifically, the Examiner has alleged that the provision of a plurality of heads would be made “to allow the surgeon to select an appropriate insert based upon the particular needs of the patient.” Wendt, however, discloses an oil wrench that includes a

slip joint adjustment 14. (See, e.g., Wendt at FIG. 1). The slip joint 14 allows “the wrench to be used for smaller or larger oil filter sizes as needed.” (Wendt at column 2, lines 59-61). Accordingly, the user merely selects the channel of the slip joint 14 which fits the particular oil can and punctures the oil can.

Therefore, while motivation to combine references may be found in an advantage arising from the combination (see MPEP 2144), there can be no advantage from the proposed combination when the alleged advantage is *already present* in the system which the Examiner proposes to modify. Accordingly, the Examiner has failed to identify a legally cognizable motivation for the combination of Wendt and Sweeney.

3. Wendt Does Not Disclose An Acetabular Liner Inserter

Moreover, the Examiner has alleged that Wendt discloses the invention of claim 20 with the exception of a plurality of heads. (Office Action at page 5). The oil wrench of Wendt cannot be used to insert an acetabular liner.

The Federal Circuit has noted that if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). With respect to claim 20, however, even if the preamble is considered to merely state an intended use, the device of Wendt cannot perform the function. Specifically, the device of Wendt incorporates a “hollow piercing jaw tooth that is connected to a drain hose via an internal oil channel through the wrench handle and jaw portion.” (Wendt at Abstract). If an acetabular liner were to be gripped by the device of Wendt, the “hollow piercing jaw tooth” would be

used to puncture the liner, thereby rendering the acetabular liner unsuitable for insertion into an acetabular cup.

Moreover, the device of Wendt grips the *outer surface* of an oil can. Gripping the outer surface of an acetabular liner inhibits insertion of the liner within an acetabular cup.

Therefore, the Wendt device is unsuitable for inserting an acetabular liner into an acetabular cup. Accordingly, the “head” of Wendt is not a “head” as recited in claim 20. Thus, even if Wendt is modified to incorporate a plurality of jaws such modification does not arrive at the invention of claim 20.

4. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the rejection of claim 20 as being obvious over Wendt in view of Sweeney has been successfully traversed, and the Applicants respectfully submit that the rejection of claim 20 under 35 U.S.C. § 103 should be withdrawn.

Discussion Re: Patentability of Claims 21-24

Claims 21-24 depend from claim 20 and includes the limitations discussed above with respect to claim 20 and additional limitations. Accordingly, for at least the same reasons set forth above with respect to claim 20, claims 21-24 are patentable over the prior art.

IV. Conclusion

A prompt and favorable action on the merits is respectfully requested.

Respectfully submitted,

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